

**REMARKS**

Claims 1-3, and 5-8 were pending in the application. No claims have been amended or canceled. New claims 9-15 have been added. Support for new claims 9-15 can be found, among other places, in original claims 1-8. Therefore, claims 1-3 and 5-15 are now pending in the application and submitted for consideration.

It is noted with appreciation that claim 2 contains allowable subject matter.

Claims 1, 3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,899,399 ("Brown") in view of U.S. Patent No. 2,586,099 ("Schultz") and U.S. Patent No. 5,794,877 ("Ono"). The rejection should be withdrawn because a *prima facie* case of obviousness has not been made. There is no motivation for combining the references.

The Office Action states that it would have been obvious to provide Brown with a steel bearing of Schultz for "the purpose of protecting the surface of the spool." Office Action at p. 2. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See also* MPEP § 2142. The motivation relied upon by the Examiner is not found in the prior art. On the contrary, only the present application identifies a problem with conventional retractors and suggests the desirability of a bearing comprising a material with a greater hardness than the spool, such as steel, as called for in claims 1 and 3. *See* Application at ¶¶ 6 and 24. Thus, the rejection is clearly based on impermissible hindsight reasoning.

There is no basis for the combination relied upon by the Examiner and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 5-8 depend from claim 3 and are allowable therewith, for at least the reasons set forth above, without regard to the further patentable subject matter set forth in these dependent claims.

New claims 9-15 call for a bearing made of steel or a bearing that "comprises a material having a greater hardness than the spool," similar to claims 1 and 3. Therefore claims 9-15 are allowable, for at least the reasons set forth above, without regard to the further patentable subject matter set forth in these claims.


Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 5/20/05

By 

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5300  
Facsimile: (202) 672-5399

Howard N. Shipley  
Attorney for Applicant  
Registration No: 39,370